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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Ice Creams and Coffee Beans, Inc.

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Serial No. 76536293

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Raymond F. Kramer, Esq. for Ice Creams and Coffee Beans, Inc.

Susan Leslie DuBois, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

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Before Rogers, Drost, and Walsh, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 11, 2003, Ice Creams and Coffee Beans, Inc. (applicant) applied to register the mark WHOLLY COW ICE CREAMS & COFFEE BEANS in standard character form on the Principal Register for “restaurant services” in Class 43. Serial No. 76536293. The application contains an allegation of January 15, 2003, as the date of first use anywhere and in commerce.

The examining attorney refused to register applicant’s mark under Section 2(d) of the Trademark Act because of a

prior concurrent use registration for the mark HOLY COW! in standard character form for "bar and restaurant services." 15 U.S.C. § 1052(d). The registration, No. 2,216,797, issued January 12, 1999, and affidavits under Sections 8 and 15 have been accepted and acknowledged. Its concurrent use area includes the states of Alabama, Arkansas, Connecticut, Delaware, Florida, Georgia, Illinois, Indiana, Iowa, Kansas, Kentucky, Louisiana, Maine, Maryland, Massachusetts, Michigan, Minnesota, Mississippi, Missouri, Nebraska, New Hampshire, New Jersey, New York, North Carolina, North Dakota, Ohio, Oklahoma, Pennsylvania, Rhode Island, South Carolina, South Dakota, Tennessee, Texas, Vermont, Virginia, West Virginia, and Wisconsin.[1] A second issue in this case is whether the examining attorney properly required a disclaimer of the term "Ice Creams & Coffee Beans" on the ground that the term is merely descriptive. 15 U.S.C. § 1056(a).

The examining attorney argues that there are only minor differences between the marks. The first is the difference in the spelling of the initial word "Holy" in

[1] A second concurrent use registration (No. 2,207,788 issued December 8, 1998) for the states of Alaska, Arizona, California, Colorado, Hawaii, Idaho, Montana, New Mexico, Nevada, Oregon, Utah, Washington, and Wyoming was also cited as a bar to registration by the examining attorney. This registration was cancelled on September 11, 2005, and it, therefore, no longer is a bar to registration.

the registered mark and "Wholly" in applicant's mark. Second, the examining attorney noted that applicant's mark includes the additional terminology "ice creams & coffee beans." Finally, the examining attorney was aware that the registered mark also included an exclamation point. Despite these differences, the examining attorney argues that the expressions "Holy Cow" and "Wholly Cow" are "slightly different in appearance" and "essentially phonetic equivalents." Brief at 4. Furthermore, the examining attorney maintains that the "phrase 'I'll meet you at the Wholly Cow' sounds exactly like 'I'll meet you at the Holy Cow.'" Brief at 5. Regarding the phrase "Ice Creams & Coffee Beans," the examining attorney points out that it identifies "the type of food items available in the applicant's restaurant. It is very common for restaurants to craft a name with a modifier that identifies the type of food available. As an informational phrase, it does not significantly alter the commercial impression created by the term 'Wholly Cow.'" Brief at 5. Therefore, the examining attorney also required a disclaimer of the term "Ice Creams & Coffee Beans."

In response to the examining attorney's refusals, applicant argues that the marks have different commercial impressions and meanings because "wholly cow" suggests

"milk, cream and other natural components of ice creams and frozen yogurts" and "the other being a deceased baseball announcer's exclamation of wonder." Brief at 3-4. Applicant also argues (Brief at 4) that, in the instant case, the services are different and that it already owns a registration for "WHOLLY COW ice creams and frozen yogurts." Regarding the disclaimer requirement, applicant maintains that its mark "ICE CREAMS & COFFEE BEANS is an incontestable registered mark on the principal register for restaurant services." Brief at 5.

After the examining attorney made the refusals final, this appeal followed.

We begin by addressing the examining attorney's requirement for a disclaimer. While the examining attorney acknowledges the prior registration for the mark ICE CREAMS & COFFEE BEANS, the examining attorney points out that the registration "is subject to a Section 2(f) limitation." Final Office Action at 4. By seeking registration under Section 2(f), applicant admitted that the mark was merely descriptive. Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact").

Obviously, a mark that registered on the Principal Register upon a showing that the mark has acquired distinctiveness under Section 2(f) is not evidence that the mark is inherently distinctive. Indeed, it is evidence that the underlying term was merely descriptive. Of course, applicant could have relied on this registration as evidence that the mark for which it currently seeks registration has acquired distinctiveness and is also registrable under Section 2(f). 37 CFR § 2.41(b); TMEP § 1212.04 (4th ed. April 2005). Applicant did not do so in this case but instead argued that the registration for "Ice Creams & Coffee Beans" is incontestable. We point out that the examining attorney is not impugning the registrability of applicant's registration under Section 2(f). Applicant simply needs to demonstrate that the term that has acquired distinctiveness in that registration has similarly acquired distinctiveness in the current application, normally by inserting a claim of distinctiveness under Section 2(f) based on its ownership of a registration on the Principal Register.[2]

Furthermore, the examining attorney's requirement for a disclaimer of the term "ice creams & coffee beans" is

[2] We add that it would have been helpful if a copy of the registrations on which applicant is relying were made of record.

reasonable. Applicant admits that its restaurants "serve mostly ice creams and coffees." Brief at 4. The term merely describes a restaurant that specializes in selling ice creams and coffee, particular coffee made from fresh ground coffee beans. The slight alliterative sound between the words "creams" and "beans" is simply not enough to turn a merely descriptive term into a suggestive term as applicant's registration under Section 2(f) demonstrates. Indeed, the examining attorney has included several registrations to show that registrations for restaurant services contain disclaimers of similar items when they are included in the mark. See, e.g., Registration Nos. 2,748,792 (JO'S JAVA AND ICE CREAM for restaurant services; "Java and Ice Cream" disclaimed); 2,696,560 (ALL AMERICAN DELI ICE CREAM for restaurants featuring deli food items, ice cream and frozen yogurt; "Deli" and "Ice Cream" disclaimed); 2,467,361 (VALENTINE'S GOURMET COFFEE & ICE CREAM for restaurants featuring coffee and ice cream; "Gourmet Coffee & Ice Cream" disclaimed); and 2,199,578 (DOLCI ICE CREAM & COFFEE PARLOR for restaurant services; "Ice Cream & Coffee Parlor" disclaimed). Third-party registrations can be used as a form of a dictionary definition to illustrate how the term is perceived in the trade or industry. In re J.M. Originals Inc., 6 USPQ2d

1393, 1394 (TTAB 1987). Therefore, without proof of acquired distinctiveness such as one based on applicant's prior registration, the examining attorney properly required a disclaimer of the term "Ice Creams & Coffee Beans."

Next, we examine the examining attorney's refusal to register under Section 2(d). In these circumstances, we look to the factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis by looking at the services in the application and the registration. The application identifies its services as "restaurant services" while the services in the registration are "bar and restaurant services." Inasmuch as both the application and the

registration include restaurant services, they are identical. When marks are used on identical goods or services, the marks do not need to be as similar. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines").

Regarding the services, we clarify two other points. Applicant makes two arguments to minimize the identical nature of the services. First, applicant argues that because registrant's services are identified as "bar and restaurant services," it "is clear that the conjunction 'and' requires that the services intended to be covered by the HOLY COW marks should be bar services and not food services alone." Brief at 4-5 (Parenthetical omitted). Applicant reads the registrant's identification of services too narrowly. There is nothing in the case law or the use of the English language that requires the interpretation that applicant suggests. All that registrant's identification means is that it must use the mark in association with restaurant services and bar services. There is no requirement that these restaurant services must include bar services. An applicant is not required to

continuously repeat the term "services" to avoid the limitation that applicant suggests. For example, such identifications as "hotel and motel services" and "retail and wholesale services in the field of…" do not require that these services be offered together. Indeed, the identifications would suggest that the services are not performed in the same location. All that registrant's identification of services requires is that registrant provide both bar services and restaurant services under the identified mark. There is no requirement that these services must always be provided in the same establishments.

Second, inasmuch as registrant's identification of services includes restaurant services, it would include all types of restaurant services. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983)("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"). Applicant has offered to amend its services to "ice cream/coffee restaurant services." Brief at 5. Applicant, however, acknowledges that "the Examining Attorney indicated that such a change would not make the application

allowable." Reply Brief at 3. Because registrant's restaurant services would include "ice cream/coffee restaurant services," this suggested amendment, even if it was formally entered, would not change the result in this case because the services would still overlap.

We add one other observation. Even if registrant's restaurants include bar services and applicant's services are limited to ice cream/coffee restaurant services, these services would not be unrelated. There is no reason why a restaurant with a bar would not also operate an informal coffee/ice cream restaurant. To the extent that these services are not identical, they would be closely related.

The next question we address concerns the similarities and dissimilarities of the marks. The marks are HOLY COW! and WHOLLY COW ICE CREAMS & COFFEE BEANS. The marks are similar to the extent that both marks include the phonetically identical term "Holy Cow" or "Wholly Cow." The examining attorney has included evidence that the terms "holy" and "wholly" would be pronounced identically. See Final Office Action, p. 3. We agree with applicant that there are differences in the marks' appearances. If the marks are studied, it would be apparent that one mark begins with the word "holy" and the other with the word "wholly." Applicant argues that the term "wholly cow"

suggests the milk, cream and other natural components of ice cream and frozen yogurt. The examining attorney admits that this is clever. However, we agree with the examining attorney that these differences in appearance would not demonstrate that there is no likelihood of confusion. Some purchasers may study the marks and interpret the marks' meanings to be different. However, many purchasers, particularly those who hear the marks, are unlikely to make such a distinction in their meanings. The commercial impressions of the marks HOLY COW! and WHOLLY COW ICE CREAMS & COFFEE BEANS emphasize the same colloquial expression, "Holy Cow."[3] Applicant may spell the word differently and some may understand that applicant is attempting to create a slightly different meaning and commercial impression, but, nonetheless, both marks call to mind the same expression "Holy Cow." While some consumers may assume that there is no association between the registered mark and applicant's mark when they are used in association with restaurant services, we cannot hold that

[3] "Holy Cow" – "*Slang.* (used to express bewilderment, surprise, or astonishment.) [1920-25]." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

this conclusion would be common among prospective purchasers.

First, "Wholly Cow" and "Holy Cow" are the first words in applicant's mark and the only words in registrant's marks and they form a conspicuous part of both marks. Aluminum Air Seal Mfg. Co. v. Trim-Set Corp., 208 F.2d 374, 100 USPQ 52, 54 (CCPA 1953) ("Both petitioner's mark and respondent's mark have 'Trim' as the first word which would be spoken in calling for the goods and as the first part of the mark "Trim' obviously forms a conspicuous part thereof and whether arbitrary, suggestive or descriptive cannot be ignored") (quoting Examiner-in-Chief's decision with approval). See also Presto Products Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) ("Although there are differences in appearance between the marks, there are also similarities between them in that both start with the term 'KID'").

Second, adding additional matter to a registered mark does not mean that there is no likelihood of confusion. See also Squirtco v. Tomy Corp., 216 USPQ at 939 (SQUIRT SQUAD for floating water toys confusingly similar to SQUIRT for balloons); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with

CONCEPT for hair care products). In this case, the additional information merely describes specialties of the restaurant and it would be less significant inasmuch as nothing prohibits registrant from also featuring ice cream and coffee made from fresh ground coffee beans in its restaurants. Furthermore, the addition of the exclamation point is unlikely to be a feature that customers would use to distinguish the marks. An exclamation mark would not significantly change the impression of the mark. Accord In re Samuel Moore & Co., 195 USPQ 237, 240 (TTAB 1977) (Descriptive mark remains descriptive despite the presence of an exclamation point in the mark). Even customers who could remember that registrant's mark included an exclamation point are likely to assume that, when the additional descriptive words were included, the exclamation point was eliminated to avoid the incongruity of having a sentence-ending punctuation mark in the middle of a group of words.

In this case, we find that the marks are dominated by the phonetically identical terms "Wholly Cow" or "Holy Cow." If "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." In re Denisi, 225 USPQ 624, 624 (TTAB 1985). We also note that applicant alleges that it is the owner of

a registration for the mark WHOLLY COW for ice cream and frozen yogurt. See Response received April 16, 2004. The ownership of this registration for goods does not mean there is no confusion when applicant now seeks a registration for restaurant services. Obviously, confusion is more likely when applicant and registrant are using the identified marks on overlapping services.

We have also considered the marks in their entireties. While there are certainly differences, we are convinced that the marks are confusingly similar. When potential customers familiar with registrant's HOLY COW! restaurants encounter applicant's WHOLLY COW ICE CREAM & COFFEE BEANS restaurants, a significant number of customers are likely to believe that there is some association as to the source of the services. In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("With respect to JOSE, the Board correctly observed that the term simply reinforces the impression that GASPAR is an individual's name. Thus, in accord with considerable case law, the JOSE term does not alter the commercial impression of the mark." The marks JOSE GASPAR GOLD and GASPAR'S ALE were determined to be similar). The likelihood of confusion is particularly enhanced when purchasers refer to the restaurants in conversations or the marks are heard in

advertising on the radio. Therefore, we conclude that confusion is likely in this case.

To the extent we have doubts, we resolve them, as we must, in favor of the prior registrant and against the newcomer. In re Hyper Shoppes (Ohio) Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 355, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862 (1992).

Decision: The refusals to register are affirmed.